REMARKS

Applicant appreciates the attention of the Examiner to the application. The final Office Action of the Examiner of August 29, 2005 has been reviewed with care in the preparation of this response. The amendment above and the following remarks are believed to be fully responsive to this action.

Status of Claims

Claims 1-2, 5-8, 12 and 15-16, as presented by the above amendment, are pending. The pending claims set forth a novel and non-obvious spinnerbait fishing lure. Reconsideration and allowance of all pending claims is respectfully requested in view of the amendment and the following remarks.

Claims 1-4, 15, 27-30, 33, 35, 36, 39, 40, 42, 43 and 46 were rejected as being unpatentable under 35 U.S.C. §103(a) over Link (U.S. Patent No. 6,601,336) in view of Ogle (U.S. Patent No. 5,253,446). Claims 5-13, 37, 38 and 41 were rejected as being unpatentable under 35 U.S.C. §103(a) over Link as modified by Ogle as applied to claims 4, 36 or 40 and further in view of Smith (U.S. Patent No. 4,640,040). Claims 14, 31, 32, 44 and 45 were rejected as being unpatentable under 35 U.S.C. §103(a) over Link as modified by Ogle as applied to claims 2, 30 or 39 and further in view of Cheng (U.S. Patent No. 4,133,134). Claims 16-20 were rejected as being unpatentable under 35 U.S.C. §103(a) over Link as modified by Ogle as applied to claim 15 and further in view of Sylla et al. (U.S. Patent No. 6,226,917).

Applicant wishes to thank the Examiner for his courtesy in making certain suggestions at counsel's request on February 28, 2006 regarding the drafting of an amendment to the claims that could overcome the pending rejections. In response to these comments, Applicant prepared and then informally proposed to the Examiner the above amendment to more clearly define the scope of the invention and distinguish it over the prior art. Applicant further thanks the Examiner for discussing the proposed amendment with Supervisory Patent Examiner Peter M. Poon and then indicating to counsel on April 5, 2006 that the proposed amendment should overcome the

rejections set forth in the final Office Action, thereby placing the application in condition for allowance. The Examiner recommended that Applicant file an RCE so as to have the amendment formally considered.

An amendment that amends claims 1, 5, 12 and 15 is therefore now being submitted. Claims 3-4, 9-11, 13-14, 17-20, 27-33 and 35-46 have been cancelled. The proposed amendment is fully supported by the specification and does not include any new matter. The claims, including those that have been amended, are patentably distinguishable over the prior art and, in particular, the references cited by the Examiner.

Applicant now turns to the particular points raised by the Examiner in the Office Action of August 29, 2005.

Rejection of Claim 1 under 35 U.S.C. §103(a)

Claim 1 was rejected under 35 U.S.C. §103(a) as being unpatentable over Link in view of Ogle. Claims 2, 5-8, 12 and 15-16 are dependent to claim 1. Obviousness under 35 U.S.C. §103(a) can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In re Jones, 958 F.2d 347 (Fed. Cir. 1992). In addition, any such combination or modification of the prior art must still teach or suggest each and every one of the claim limitations. MPEP §2143. The references cited by the Examiner, however, do not teach or suggest all of the limitations set forth in amended claim 1.

The spinnerbait lure set forth in amended claim 1 includes a frame formed in a molding process and the present amendment clarifies that the jig-head that is embedded within that frame is irremovably embedded within the lower distal-end of the frame's lower arm by molding polymeric material around it. Claim 1, as amended, also includes specific limitations drawn from claims 3, 4, 9-11, 13 and 14, each now cancelled.

The Examiner asserts in the Office Action that an embedded jig is disclosed only in Link and points to FIGS. 4 and 10 of that reference. In FIG. 4, the "jig" being referenced by the

Examiner is a support rattle assembly 61. This assembly, however, has a flanged headpiece that is shaped to interconnect with, i.e. snap into, the recessed cavity of the end cap 24 at the end of each filament 22. (Link at col. 3, lines 34-42 and 62-65). In FIG. 10, jig 90 is shown fitted with the elastomeric collar 92 of what the Examiner asserts is a frame, the collar having a bore running its length that allows it to be slipped over the shaft of the jig. (Link at col. 4, lines 44-45; col. 7-8).

Neither embodiment in the reference teaches or suggests that the jig-head in question is irremovably embedded within the elastomeric "frame" through a molding of polymeric material around it. Moreover, there is nothing shown in any of the other embodiments disclosed in Link disclosing this limitation. Quite to the contrary, in each instance, the dressing is a modular assembly that is no more than frictionally attached to the desired jig to provide for a variety of combinations and mounting arrangements in constructing a lure. (Link at col. 1, lines 29-32). This flexibility in removing or exchanging the assembly is in fact taught as being highly desirable in certain embodiments over having it molded to the lure. (Link at col. 5, lines 54-57).

The Examiner also asserts that Link discloses a frame having upper and lower arms in a predetermined shape in a non-stressed condition. The "frame" he points to in FIG. 4, however, is an elastomeric dressing to be attached to a fishing lure having a collar 60 and two filaments 22 extending outward from the collar. There is no teaching or suggestion in Link that this elastomer assembly has a predetermined shape to which it returns whenever in a non-stressed condition. Elastomeric material permits the filaments to be deformed into any desired shape. (Link at col. 5, lines 54-57). Moreover, since they are no more than filaments, these elastomer appendages to the collar will be continuously returning to a flaccid configuration after force-induced flexing is withdrawn, leaving the elastomer assembly in a shape that is continuously changing over time.

Amended claim 1 further includes the limitation that the frame is adapted to attach to a fishing line/leader substantially adjacent to the frame-vertex. This feature is also neither taught nor suggested by either Link or Ogle. The Examiner points to the eye 10 of the jig-head 4 in FIG. 1 of Link as showing this feature. Eye 10 is, however, not substantially adjacent to but remote from what must constitute the frame-vertex in that figure – the elastomer collar 20. In

Ogle, the Examiner points to link 20 in FIG. 1 as disclosing this feature. Since link 20 has a fishing line or leader attached to it at loop 20c, the Examiner is presumably referring to the point on ring 12, as shown in FIG. 1, where loop 20a of link 20 is resting as constituting the frame-vertex. This does not teach or suggest, however, a frame-vertex from which the upper and lower arms of the frame extend divergently. Such a feature is more clearly seen in FIG. 1 at point 14 of ring 12 from where arms 16 and 19 extend. This is on the opposite side of the ring from link 20 and, therefore, not at all adjacent to where the fishing line/leader attaches to the frame.

Amended claim 1 also requires that the frame be formed in a molding process from transparent polymeric material. The Examiner agrees that this limitation is not disclosed by either Link or Ogle. Although the Office Action points to the hollow tube 10 of the device in Cheng as teaching this restriction, this tube is only for receiving water soluble scented bait. This tube is rotatably mounted upon an elongated spinner shaft 11 to which is secured a blade and jig. (Cheng at col. 2, lines 57-66; FIGS. 4-6). Any disclosure in Chang, therefore, as to a frame is more properly directed to this shaft which Chang teaches is made from a length of stiff metal wire, not transparent polymeric material. (Cheng at col. 2, lines 59-62).

Although the Examiner agrees that Link does not disclose a frame formed from an integral length of polymeric material, he asserts that Ogle shows such a frame, pointing specifically to column 4, lines 20-34 of that reference. This portion of the Ogle specification states that alternative embodiments of its lure may include "an elliptical ring made from polymeric materials."

The lure in Ogle is comprised, however, of both the ring 12 and two extension arms 16, 19. (Ogle at col. 3, lines 26-30). Ogle teaches a flow-through lure and the ring is an essential but distinct component from its arms since it serves to give the lure the profile and size of minnow bait and to form an aperture that enables fluid to flow through it. (Ogle at col. 4, lines 11-16, 35-40). A hook 17 and a spinner attachment 18 are secured to arms 16 and 19 respectively and not to the ring. (Ogle at col. 3, lines 41-49). There is no disclosure in Ogle of the arms being formed from plastic much less the asserted "frame", i.e., ring and extension arms, being made from a single piece of polymeric material.

Even if Ogle could arguably be said to show a frame having at least one blade and a jig secured to it and formed from an integral length of polymeric material, the Examiner has nevertheless failed to make the necessary showing of reasons or motivation within Link and Ogle that would support the combination and modification relied upon him in having rejected claim 1 under §103(a). The Examiner makes reference in the Office Action to how "it would have been obvious to one of ordinary skill in the art to take the device of Link and add the polymeric material of Ogle, so as to allow for the device to be made of differing colors attractive to fish." This statement, however, is not the required showing of a motivation within the teachings of these references that one needs to have arrived at Applicant's claimed invention. A specific explanation as to how a skilled artisan can extrapolate the invention from either Link or Ogle must be set forth by the Examiner. MPEP §706.02(j).

The Examiner may not simply select from the prior art the separate components of the claimed invention through the use of the blueprint supplied by the Applicant. Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 227 USPQ 543 (Fed. Cir. 1985). The act of identifying the various elements of the claimed invention in the prior art without there being any teaching, suggestion or motivation for their combination is not the legal test of obviousness. It is, after all, well recognized that most, if not all, inventions are no more than combinations of old elements in the prior art. Environmental Designs, Ltd. V. Union Oil Co., 713 F. 2d 693, 218 USPQ 865 (Fed. Cir. 1983); Richdel, Inc. V. Sunspool Corp., 714 F. 2d 1573, 219 USPQ 8 (Fed. Cir. 1983). "If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be 'an illogical and inappropriate process by which to determine patentability.' Sensonics, Inc. v. Aerosonic Corp., 81 F. 3d 1566, 1570, 38 USPQ 2d 1551, 1554 (Fed. Cir. 1996)." In re Rouffet, 47 USPQ 2d at 1457 (Fed. Cir. 1998).

In addition, Link teaches against the modification suggested by the Examiner whereby the elastomeric material in the assembly pointed to by the Examiner is substituted with polymeric

material. This change creates an assembly that always retains its original configuration absent undergoing flexing sufficient to break it. Such an assembly would lose its ability to have its collar easily snap on or off a lure or to permit various spinner blade or rattle assemblies to removably attach to one or more of its filaments. (Link at col. 1, lines 6-11, 29-32). This modification would also defeat the previous ability of the assembly to allow its arms or filaments to be formed into any desired shape. (Link at col. 5, lines 54-57). In addition, such a change would completely eliminate the ability of the filaments to be tailored to arrive at a certain preferred flexibility so that it matches, for example, that of an attached multi-stranded skirt or artificial bait. (Link at col. 1, lines 34-38). If a proposed combination changes the principle of operation of the prior art being modified, the teachings of the references are then not sufficient to render the claim prima facie obvious. MPEP §2143.01.

Nowhere in Link is there a teaching or suggestion that replacing the elastomer with certain polymers is, in any way, needed or desirable. It is simply an exercise in hindsight for the Examiner to call upon the supposed level of skill of one skilled in the art and then assert that the desired motivation comes from a need to make the assemblies different colors. If color was at all considered desirable by a skilled artisan, such color could be easily and more efficiently added to the elastomeric material itself. This can be seen with any box of colored rubber bands. The proposed modification by the Examiner is both impractical and would make the device in Link highly unsatisfactory for its obviously intended purposes.

For all of these reasons, a prima facie case of obviousness has not been established by the Examiner such that a rejection of amended independent claim 1 can be maintained. Applicant believes, therefore, that this rejection has been traversed and should be withdrawn. Moreover, this claim and claims 2, 5-8, 12 and 15-16 that depend from it should now be allowed.

Conclusion

Applicant's invention, as set forth in the pending claims, represents a highly novel and non-obvious spinnerbait lure. This improved fishing lure offers advantages that include having a frame formed from an integral length of polymeric material that allows the frame to recover its

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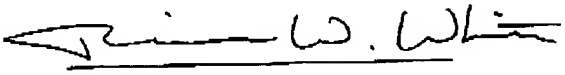
Inventor: Fasnacht

original configuration after undergoing non-destructive bending and having a jig secured to the lure by embedding it within the frame so that the lure has increased durability and is environmentally safe. These are advantages not offered by any of the fishing lures disclosed by the prior art cited in the present Office Action. Moreover, Applicant believes that the now pending claims 1-2, 5-8, 12 and 15-16 have several other elements not disclosed or suggested in the prior art.

Applicant submits that all rejections to these claims in the Office Action have been traversed by amendment and argument, placing these claims in condition for allowance. Applicant respectfully requests therefore that these rejections be reconsidered and withdrawn by the Examiner. Early favorable action is earnestly solicited. The Examiner is invited to call the undersigned if such would be helpful in resolving any issue which might remain.

Please debit Deposit Account 10-0270 for a two-month extension fee. If any additional fees are due, please debit Deposit Account 10-0270 and inform the undersigned.

Respectfully submitted,



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